

### **REMARKS/ARGUMENTS**

In the Office Action mailed January 30, 2008 (hereinafter, "Office Action"), claims 1-19 and 21-32 stand rejected under 35 U.S.C. § 103. Claim 33 has been added.

Applicant respectfully responds to the Office Action.

#### **I. Claims 1-3, 7-13, 15, 18, 21-27, and 29-32 Rejected Under 35 U.S.C. § 103(a)**

Claims 1-3, 7-13, 15, 18, 21-27, and 29-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,130,284 to Lee, et al. (hereinafter, "Lee") in view of U.S. Patent No. 7,123,910 to Lucidarme, et al. (hereinafter, "Lucidarme"). This rejection is respectfully traversed.

The factual inquiries that are relevant in the determination of obviousness are determining the scope and contents of the prior art, ascertaining the differences between the prior art and the claims in issue, resolving the level of ordinary skill in the art, and evaluating evidence of secondary consideration. KSR Int'l Co. v. Teleflex Inc., 550 U.S. \_\_\_, 2007 U.S. LEXIS 4745, at \*\*4-5 (2007) (citing Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18 (1966)). To establish a *prima facie* case of obviousness, the prior art references "must teach or suggest all the claim limitations." M.P.E.P. § 2142. Moreover, the analysis in support of an obviousness rejection "should be made explicit." KSR, 2007 U.S. LEXIS 4745, at \*\*37. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." Id. (citing In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Applicant respectfully submits that the claims at issue are patentably distinct from the cited references. The cited references do not teach or suggest all of the subject matter in these claims.

For example, independent claim 1 recites, among other subject matter, "a first modem processor operative to . . . receive a search message carrying a list of frequencies to search for cells in the second wireless network" and "a second modem processor operative to determine pilot acquisition for the list of frequencies and additional frequencies not included in the list of frequencies to produce a search result." (Emphasis added). Independent claims 13, 15, 18, 27, and 29 each include similar subject matter. Lee, alone or in combination with Lucidarme, does not teach or suggest this subject matter.

In making the rejection, the Examiner relies on Lee to show a second modem processor operative to determine pilot acquisition for the list of frequencies. However, the Examiner acknowledges that Lee fails to disclose determining pilot acquisition for additional frequencies not included in the list of frequencies. (See Detailed Action, page 2, numbered paragraph 5).

The Examiner relies on Lucidarme to cure this deficiency. Specifically, the Examiner indicates that Lucidarme teaches “scanning all available radio spectrum for identifying potential radio networks.”

In response, Applicant first reiterates that Lee teaches away from time-consuming searches. As can be seen with reference to the description of Figure 3 (Col. 6, line 56-Col. 8, line 24), Lee teaches that the handoff process is a time critical process so that taking a long time to perform pilot searches results in a detrimental effect such as a loss of data communication between the async base station and the mobile station. (Lee, Col. 8, lines 24-27).

Lee further reinforces the importance of minimizing the time spent on this process by teaching that the “mobile station can search for the candidate cells with a small window size and send reliable search results to the base station in a shortest time, thereby reducing any potential risk of call disconnection.” (Emphasis added) (Lee, Col. 15, lines 34-39). Thus, Lee solves the time problem discussed in regards to Figure 3 by only having the mobile station search the candidate cells.

Turning now to Lucidarme, a methodology is described that squarely opposes the teachings of Lee. For example, the cited portions (Col. 9, lines 8-20) of Lucidarme disclose:

In one embodiment, the mobile terminal 10 scans available radio spectrum rather than receiving specific instructions via the UMTS network 20 or other means as to cells and frequencies to monitor. By scanning all available radio spectrum and identifying potential radio networks a maximum of flexibility in system handover is provided thus providing the best opportunity for the QoS requirements to be met successfully. However, a complete scan requires time. Often, a mobile terminal 10 can collect information as to other available radio access networks over a protracted period of time, e.g. remains in one locality. However, if the mobile terminal 10 is moving quickly this may not be possible. (Emphasis added).

Clearly, Lucidarme teaches that the entire available radio spectrum should be scanned rather than receiving specific instructions as to which cells and frequencies to monitor.

Ironically, Lucidarme goes on to acknowledges that such a complete scan will require time, which Lee goes to great lengths to avoid.

Based on the foregoing, Applicant submits that Lee and Lucidarme are not properly combinable since they both teach away from each other. Namely, Lee teaches away from scanning more than the list of candidate frequencies in order to save time, and Lucidarme advocates for the scanning of the entire available radio spectrum, rather than just scanning a list of frequencies or cells, in order to obtain maximum flexibility in system handover. One of skill in the art could not objectively arrive at the subject matter of Applicant's independent claims 1, 13, 15, 18, 27, and 29 regarding "receiving a search message carrying a list of frequencies to search for cells in a second wireless network and determining pilot acquisition for the list of frequencies and additional frequencies not included in the list of frequencies" without the use of improper hindsight due to the fact that Lee and Lucidarme clearly teach away from each other.

In light of the foregoing, Applicant respectfully requests withdrawal of the rejection of independent claims 1, 13, 15, 18, 27, and 29. Claims 2-3, 7-12, 21-26, and 30-32 depend either directly or indirectly from claims 1 and 18, respectively. Thus, Applicant submits that claims 2-3, 7-12, 21-26, and 30-32 are allowable at least for the reason that they depend from an allowable base claim.

## **II. Claims 4-6, 14, 16, 17, 19, and 28 Rejected Under 35 U.S.C. § 103(a)**

Claims 4-6, 14, 16, 17, 19, and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee and Lucidarme in view of U.S. Patent Application Publication No. 2004/0203469 to Patel, et al. (hereinafter "Patel") and U.S. Patent Application Publication No. 2003/0139184 to Singh, et al. (hereinafter "Singh"). This rejection is respectfully traversed.

Claims 4-6, 14, 16, 19 and 28 depend either directly or indirectly from claims 1, 13, 15, 18, and 27, respectively. Thus, Applicant submits that claims 2-3, 7-12, 21-26, and 30-32 are allowable at least for the reason that they depend from an allowable base claim.

Independent claim 17 includes subject matter similar to that described above in regards to independent claims 1, 13, 15, 18, 27, and 29. For example, among other subject matter, claim 17 recites "means for sending a search message carrying a list of frequencies to search for cells in the second wireless network; means for receiving a search result comprising pilot acquisitions determined for the list of frequencies and

additional frequencies not included in the list of frequencies.” As previously discussed, Lee and Lucidarme cannot be combined to render at least this subject matter of claim 17 obvious. Patel and Singh do not cure the deficiencies of Lee and Lucidarme.

Accordingly, Applicant respectfully requests withdrawal of the rejection of claim 17.

### **III. Claim 17 Rejected Under 35 U.S.C. § 103(a)**

Claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Singh in view of Patel in view of Lucidarme. This rejection is respectfully traversed.

In making the rejection, the Examiner acknowledges that Singh fails to disclose means for sending a search message carrying a list of frequencies to search for cells in the second wireless network and means for receiving a search result comprising pilot acquisitions determined for the list of frequencies and additional frequencies not included in the list of frequencies. The Examiner relies on Lucidarme to cure this deficiency. (See Detailed Action, page 9, numbered paragraph 8).

In response, Applicant notes that, as described above, Lucidarme clearly teaches away from searching frequencies from a list. In fact, the cited portion of Lucidarme describes “scanning the available frequencies and detecting and measuring available radio resources.” (Emphasis added) (Lucidarme, Col. 9, lines 2-3). However, the cited portions of Lucidarme make no mention of means for sending a search message carrying a list of frequencies to search for cells in the second wireless network and means for receiving a search result comprising pilot acquisitions determined for the list of frequencies and additional frequencies not included in the list of frequencies, as recited in Applicant’s claim 17.

In light of the foregoing, Applicant respectfully requests withdrawal of the rejection of independent claim 17.

### **IV. New Claim 33**

Claim 33 has been added. Applicant submits that claim 33 is fully supported by Applicant’s specification. (See Specification, paragraphs [0091]-[0092] and Figure 2.) Claim 33 includes subject matter similar to the subject matter described hereinabove. As such, Applicant submits that claim 33 is patentable for at least the same reasons as those previously described.

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**CONCLUSION**

In view of the foregoing, Applicants respectfully submit that all pending claims in the present application are in a condition for allowance, which is earnestly solicited. Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number provided below.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

Dated: June 30, 2008

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